

REMARKS

Applicant has carefully reviewed the Application in light of the Office Action mailed July 14, 2006. At the time of the Office Action, Claims 1-37 were pending in the Application. Applicant amends Claims 1, 12, 23, and 34-37 and cancels Claims 9, 19, and 30 without prejudice or disclaimer. The amendments and cancellation to these claims are not the result of any prior art reference and, thus, do not narrow the scope of any of the claims. Furthermore, the amendments are not related to patentability issues and only further clarify subject matter already present. All of Applicant's amendments have only been done in order to advance prosecution in this case. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Section 102 Rejection

The Examiner rejects Claims 1-21 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,658,095 issued to Yoakum et al. (hereinafter “*Yoakum*”). Applicant respectfully traverses this rejection for the following reasons.

Applicant respectfully reminds the Examiner that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.¹ In addition, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claims” and “[t]he elements must be arranged as required by the claim.”² In regard to inherency of a reference, “[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.”³ Thus, in relying upon the theory of inherency, an Examiner must provide a basis in fact and/or technical reasoning to support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.⁴

¹ *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131.

² *Richardson v. Suzuki Motor Co.*, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 USPQ 2d 1566 (Fed. Cir. 1990); MPEP §2131 (*emphasis added*).

³ MPEP §2112 (citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ 2d 1955, 1957 (Fed. Cir. 1993) (*emphasis in original*)).

⁴ MPEP §2112 (citing *Ex Parte Levy*, 17 USPQ 2d 1461, 1464 (Bd. Pat. and Inter. 1990) (*emphasis in original*)).

There are a multitude of reasons why the pending claims are allowable over the proposed reference. However, Applicant will not inundate the Examiner with all such reasons as a courtesy to the Examiner. One significant difference is that *Yoakum* fails to offer any disclosure relating to the ability to control end point devices. As recited, Independent Claim 1 recites, “an authorized user at an endpoint is able, using IM, to instruct one or more discovered network devices to perform one or more particular tasks.”

For this teaching, the Examiner has incorrectly relied on Columns 11 and 12 of *Yoakum*. No such teaching is offered in these passages, as Applicant has reviewed the cited disclosure several times. The aforementioned functionality, which is lacking in *Yoakum*, allows control of presence end points via the sent control commands. Because *Yoakum* is incapable of such operations, *Yoakum* is not a barrier to patentability for Independent Claim 1. Accordingly, Independent Claim 1 is allowable over this reference for at least this reason.

In addition, Independent Claims 1, 12, 23, and 34-37 recite a similar limitation and, therefore, are also allowable using analogous reasoning. Additionally, the corresponding dependent claims are also allowable over the cited reference using a similar rationale. Written notice to this effect is respectfully requested.

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CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant believes no fee is due. However, if this is not correct, the Commissioner is hereby authorized to charge any additional amount required or credit any overpayment to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact Thomas J. Frame at 214.953.6675.

Respectfully submitted,
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